



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,350	02/21/2002	Masayasu Asano	NIT-331	5054

7590 01/04/2007
MATTINGLY, STANGER & MALUR, P.C.
ATTORNEYS AT LAW
SUITE 370
1800 DIAGONAL ROAD
ALEXANDRIA, VA 22314

EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
----------	--------------

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/078,350

Applicant(s)

ASANO ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20020221, 20061201</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of 1 – 3 and 6 – 8 in the reply filed on 02 October 2002 is acknowledged. Applicant has not provided any grounds / arguments for traversal. This is not found persuasive. The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claim 6 is objected to because of the following informalities: Claim 8, last line recites "and are presented them to the users". To expedite the prosecution of the application, applicant reads the limitation as " and are presented ~~them~~ to the user". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 3 and 6 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the

Art Unit: 3629

subject matter which applicant regards as the invention. It is clear whether there is any service provider personnel involvement or the system functions on its own directly with the user. Also, applicant has not positively claimed whether the claimed invention is for existing customers only because it is not clear applicant gets information on current status of storage usage of new customers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. US Patent 6,067,525.

Regarding claims 1 and 6, Johnson teaches system and method for computerized sales force automation process for multiple phase of sales process. Johnson does not specifically teach sales process for providing storage rental services for the storage operational system. However, it is old and known to one of ordinary skill in the art that in the sales industry, services is also considered a product which requires Marketing and Sales.

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Johnson invention can handle automation of sales wherein sales can be sales of services which is a product sold by a business entity.

Johnson teaches lifecycle of sales process. Johnson teaches:

getting information on said current status of storage usage of said storages [Fig. 21 and disclosure associated with Fig. 21];

getting the users' set-up requirements for said storages [Fig. 21 and disclosure associated with Fig. 21];

creating proposed set-ups for storage spaces on said storages based on said set-up requirements by the users and said information on current status of storage usage of said storages for presenting to the users [Fig. 21 and disclosure associated with Fig. 21];

setting prices to be charged to the users for the said created [Fig. 21 and disclosure associated with Fig. 21];

proposed set-ups of said storage spaces on said storages [Fig. 21 and disclosure associated with Fig. 21];

making the users select any of said created, proposed set-ups of said storage spaces on said storages [Fig. 21 and disclosure associated with Fig. 21]; and

setting said storage spaces on said storages depending on the selection [Fig. 21 and disclosure associated with Fig. 21],

Even though Johnson does not explicitly teach creating next-best proposed set-ups (i.e. next-best proposed solution) when all of said requirements cannot be satisfied

Art Unit: 3629

and present them to the users, it is old and known to one of ordinary skill in the art that a sales entity will generate next-best proposed solution when all of said requirements cannot be satisfied to prevent the situation of completely losing the potential customer.

Regarding claims 2 and 7, as responded to earlier, Johnson teaches allowing the system to present the result from comparison with users' requirements for set-ups simultaneously when creating the proposed set-ups satisfying partially said users' requirements for set-ups and presenting them to the users (John teaches configurator).

Allowable Subject Matter

Claim 3 is deemed allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 8 is deemed allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and minor informality, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

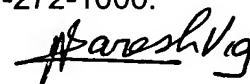
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. King et al. US Publication 2002/0152133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig
Examiner
Art Unit 3629

December 28, 2006